

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

I. Summary of Amendments to the Claims

Claim 58 is requested to be cancelled without prejudice or disclaimer.

Claim 55 is currently being amended. Support for this amendment can be found throughout the specification as-filed, including original claims 1 and 6 and page 9, lines 6-15. No new matter is being added.

Claims 59 and 60 are being added. Support for claim 59 can be found throughout the specification as-filed, including original claim 1. Support for claim 59 can be found throughout the specification as-filed, including original claim 1 and page 9, lines 6-15.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 55, 59, and 60 are now pending.

II. Provisional Rejections – Double Patenting

Claims 55 and 58 stand “provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-12 of copending Application No. 10/146,130.” Office Action at 3. According to the Office Action, the cited claims “are not patentably distinct from each other.”

Applicants note the provisional nature of the rejection and will address the rejection when, if ever, it matures into a non-provisional rejection.

III. Claim Rejections – 35 U.S.C. § 112, First Paragraph

Claims 55 and 58 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the specification allegedly does not denote a “HARL” core sequence but only denotes longer core sequences that contain “HARL.” Accordingly, the Office Action argues that the claims “define a new sub-genus not supported by the specification as originally filed.” Office Action at 5.

The specification contains clear support for the “H A R L” core sequence recited in claim 55. Indeed, the specification states that the present invention is directed to Harlil peptides and that “Harlil peptides encompassed by the invention include, but are not limited to [eight specifically defined peptides].” Spec. at p. 5, ll. 14-17 (emphasis added). The originally filed claims expound on the Harlil peptides encompassed by the invention. Specifically, original claim 1 was drawn to peptides encompassing all eight sequences in addition to other sequences, including “H A R L.”¹ Thus, claim 1 makes clear that Applicants possessed the core sequence “H A R L” at the time of filing and regarded the sequence as part of the invention.

In addition, the originally filed claims and specification evince clear support for the particular combination of recited elements. Specifically, original claim 6 recites: “A peptide having the amino acid sequence H A R L, and comprising at least one and up to 25 additional amino acids flanking either the 3’ or 5’ end of the peptide.” In addition, the specification clarifies the scope of the phrase “at least one and up to 25 additional amino acids”. Specifically, the specification states that the additional amino acids are those found flanking the H A R L sequence in native NTP, and that preferably, the peptide “does not exceed 25 total amino acid residues in length.” Spec. at p. 9, ll. 6-15. In other words, the text describes an NTP fragment no more than 25 amino acids in length containing the H A R L sequence. Thus, the specification and originally filed claims contain clear support for the H A R L sequence in combination with element (b) of claim 55.

¹ Original claim 1 explicitly recites all eight exemplar Harlil peptides, except for “H H A R L I F.” However, “H H A R L I F” would be encompassed by the claim, because the claim recites “H A R L I F.”

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of this ground of rejection.

IV. Claim Rejections – 35 U.S.C. § 102

Claims 55 and 58 stand rejected under 35 U.S.C. § 102 as allegedly anticipated. The rejections are addressed below.

A. Claim 58

While not acquiescing in the propriety of the rejections, Applicants have cancelled claim 58. Thus, the amendment renders the rejections of claim 58 moot.

B. Claim 55 – U.S. Patent No. 5,834,287 to Kubota *et al.*

Claims 55 and 58 stand rejected under 35 U.S.C. §§ 102(e) and (b) as allegedly anticipated by U.S. Patent No. 5,834,287 to Kubota *et al.* (“Kubota”) as further evidenced by U.S. Patent No. 5,830,670 to de la Monte *et al.* The examiner cites Kubota’s SEQ ID NO: 8 because it contains 17 amino acids and contains the HARL sequence. The examiner claims SEQ ID NO: 8 satisfies the recitation of claims 56(b) and 58(b), because the amino acids of SEQ ID NO: 8 occur somewhere in the NTP sequence. In other words, the examiner alleges that “[t]he claim does not require that the amino acids bear any particular homology to any particular portion of the neural thread protein sequence but merely require that they may be found in the full length sequence.” Office Action at 9. Applicants respectfully traverse this ground of rejection.

Kubota fails to teach each and every element of claim 55, as amended. Specifically, Kubota does not relate to NTP but instead discloses enzymes that release trehalose from certain non-reducing saccharides. Thus, Kubota fails to teach or suggest a peptide not exceeding 25 amino acids in length that “has 100% homology to a Neural Thread Protein (NTP) sequence.” Accordingly, Kubota fails to anticipate the claimed invention.

For at least this reason, Applicants respectfully request reconsideration and withdrawal of this ground of rejection.

CONCLUSION

The present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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